

Appl No. 09/897,921

Amdt Dated August 18, 2005

Reply to Office Action of April 18, 2005

REMARKS/ARGUMENTS

In the Office Action, claims 1, 2, 6, 7, and 18 were rejected.

Remarks Regarding Amendments

Claims 1 and 18 have been amended Claim 19 has been newly submitted herewith.

In claim 1, the term "existing route" has been added to more clearly define a route extending between the first and second points and, to the extent that the term "alternate route" appearing later in claim 1 is a relative term, to explicitly define the structure to which the "alternate route" is an alternate. Also in claim 1, the "shoreline length" and the "road length" of the further road are now explicitly recited and defined in the claim, and the further road and the shoreline are defined as being parallel along their respective lengths to more particularly and distinctly claim aspects of the invention. Applicant submits that these amendments add no new matter but, are supported by the text of the specification (see, for example, paragraph 16) and/or merely make explicit that which was formerly implicit in the specification.

In claim 18, the term "substantially equal to" has been deleted from the claim and reference to the "existing route" has been added, consistent with amended claim 1.

In claim 19, the length of the alternate route is specifically defined as including the length of the further road combined with the lengths of first and second links for connecting the further road to the first and second points, and that the alternate route length is generally equal to or greater than the length of the existing route between the two points. Applicant submits that this amendment

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more particularly claims an aspect of the present invention that the further road is not provided to shorten a distance between two points, as is the case with typical known bridges, for example, but is rather provided to divert traffic from a tract land to above an adjacent body of water (see, for example, paragraph 16 of the Description). Applicant submits that the subject matter of claim 19 is fully supported by the specification. With reference to Figure 1, an alternate route of generally equal length to an existing route is supported by the specification by, for example, considering the length of the further road 26 (between the links 32 and 36) combined with the length of the links connecting the road 26 to points 28 and 30, which provides an alternate route length generally equal to the length of the existing road 18 extending between points 28 and 30. An alternate route of greater length is supported by considering, for example, the length of the links 32 and 36 combined with the length of the further road 26 between them, as compared to the length of the existing road 18 between the links 32 and 36.

In view of the above, Applicant respectfully submits that the amendments submitted herewith are properly supported by the specification as filed, and entry of the amendments is respectfully requested.

Remarks Regarding Rejections—Obviousness

The Examiner rejected claims 1, 2, 6, and 18 as being obvious in view of Wright et al. combined with a map of the road system around Monona Bay, Madison, Wisconsin. The rejections were made first with reliance on Wright et al. as the primary reference, and second with reliance on the map of the Monona Bay road system as the primary reference. In each case, the Examiner stated that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods discussed by Wright et al. to obtain the system of roadways in Madison in order to obtain an efficient plan for

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design and implementation" (page 3, line 6-9 and page 3, lines 17-20, of the Office Action dated April 18, 2005)

With respect, Applicant submits that the rejection is improper in that it fails to set out whether or not the combined prior art teaches or suggests the limitations of the claims rejected by such *combination* of prior art. The Examiner has merely correlated some of the claim limitations to features of the map reference alone, and then concluded that the Monona Bay road system is obvious in view of the Wright reference, and that the Monona Bay road system is an efficient plan for design and implementation. There is no indication that each of the limitations of the rejected claims have been deemed obvious by the combination of the prior art references. Applicant submits that "the system of roadways in Madison" and an "efficient plan for design and implementation" appear nowhere as limitations in the rejected claims

The requirement that all the claim limitations must be taught or suggested by the prior art in order to establish a prima facie case of obviousness is clearly set out in the MPEP (see, for example, MPEP 2143.03). The MPEP further states that the "Office Action should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings" (MPEP 2144.08 III). Applicant respectfully submits that the Office Action has failed to articulate how, if at all, the limitations of the rejected claims are taught or suggested by the combined prior art. Applicant respectfully submits that the requisite prima facie obviousness of claims 1, 2, 6, and 18 has not been established, and withdrawal of the rejection is respectfully requested.

The Examiner further rejected claim 7 as being obvious in view of the Monona Bay road system as combined with Wright et al. and Haakonsen (U.S. Pat. No. 5,216,773). The Examiner explained that Haakonsen teaches a method of installing a floating road, and concluded that it "would have been obvious to one

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of ordinary skill in the art at the time the invention was made to have used this method in order to obtain another bridge, thereby increasing roadway capacity across Monona Bay".

Applicant respectfully submits that this rejection is improper for similar reasons as the rejection discussed above. This rejection of claim 7 fails to set out whether or not the combined prior art teaches or suggests the limitations of the claims rejected by such combination of prior art. The Examiner has concluded that, in view of the cited references, it would have been obvious to obtain another bridge to increase roadway capacity across Monona Bay. There is no indication that any limitations of claim 7 have been deemed obvious by a combination of these references. Applicant submits that obtaining "another bridge" and "increasing roadway capacity across Monona Bay" appear nowhere as limitations in rejected claim 7.

In view of the above, Applicant respectfully submits that the requisite prima facie obviousness of claim 7 has not been established, and withdrawal of the rejection is respectfully requested

To expedite allowance, Applicant provides the following further comments with respect to the prior art cited in the Office Action.

The Wright reference and the Haakonsen reference have been cited in previous Office Actions. The map of the Monona Bay road system of Madison, Wisconsin, has been newly cited in the subject Office Action of the present Response.

Applicant respectfully submits that the map of the Monona Bay road system does not teach or suggest the limitation that the further road (i.e. John Nolan Dr.) and the shoreline are parallel along their respective lengths, as claimed in amended claim 1. The length of the shoreline, as defined by amended claim 1, extends

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generally between the first point (on S. Broom St. at John Nolan Dr.) and a second point (on W. Lakeside St. at John Nolan Dr.), along the edge of the land bounding Monona Bay. The length of the further road, as defined by amended claim 1, generally spans the distance between the first and second points.

In the map of the Monona Bay road system, the corresponding "further road" (i.e. John Nolan Dr.) extends substantially north-south between the first and second points, and the shoreline extends generally in a C-shaped semi-circle that starts and ends at the two points, and is disposed generally to the west of the further road. It is clear that John Nolan Dr. and the shoreline are not generally parallel along their respective lengths, thus failing to teach or suggest this limitation of amended claim 1.

Applicant respectfully submits that the Wright et al. and Haakonsen references similarly fail to teach or suggest a method of routing traffic in which a further road and a shoreline are generally parallel along their respective lengths, as claimed in amended claim 1.

In view of the above, Applicant respectfully submits that the combination of the cited references fails to suggest or teach all of the claim limitations of amended claim 1, and that amended claim 1 is accordingly non-obvious in view of these references.

Claims 2, 6, 7, 18, and 19 depend directly from independent claim 1. Applicant submits that these claims are therefore allowable in that they depend from an allowable base claim, as argued above.

Furthermore, regarding claim 18, Applicant respectfully submits that the at least one existing road, by definition in claim 1, is a road or roads on which both the first and second points are located. The Examiner appears to have identified the

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first and second points as being located on S. Broom St. and W. Lakeside St., respectively, generally at either end of John Nolan Dr. In accordance with claim 1 (both in its previous and currently amended form), an "at least one existing road" as defined by the claim language would be satisfied by (starting at the first point), the portion of Hwy 151 extending generally West from S. Broom St. to W Washington Ave, and then south-west toward Vilas Ave, then south to W Lakeside Ave, and the portion of W. Lakeside Ave. extending east to the second point. This path defines an "existing route" in accordance with the meaning of the term as used in amended claims 1 and 18, and it is readily apparent that the length of the further road (i.e. John Nolan Dr between the two points) is far shorter than the length of this existing route, thus contrary to the limitation of amended claim 18.

In rejecting former claim 18, the Examiner appears to have identified "the existing road" as being the portion of W. Washington Ave. between Hwy 151 and Regent St. With respect, this portion of roadway fails to have either the first or second points located thereon, and so cannot be considered to fall within the limitation of "an existing road" as defined by claim 1.

To define the comparative lengths of claim 18 more clearly, Applicant has amended claim 1 to recite that an existing route is defined by the first point and second point located on at least one existing road. The length of the further road in amended claim 18 is then compared to the existing route. Applicant submits that the map of the Monona Bay road system does not teach or suggest the limitations of amended claim 18, and that amended claim 18 is allowable over the cited references for this additional reason.

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Remarks Regarding Rejections--35 USC §112

The Examiner rejected the subject matter of claim 18 as amended in the Amendment dated July 3, 2003 on the grounds that "substantially the same" introduced new matter.

Applicant has amended claim 18 to remove the term "substantially the same" so that this rejection is now moot. Applicant respectfully submits that the subject matter of amended claim 18 is supported by the specification and withdrawal of this rejection is respectfully requested.

Applicant respectfully submits that the present application is now in condition for allowance, and Applicant requests that a timely Notice of Allowance be issued in this case. Should the Examiner identify any further outstanding issues, Applicant invites the Examiner to call the undersigned at (416) 957-1697

If additional fees are required, please charge the fees to our Deposit Account No. 02-2095.

Respectfully submitted,

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